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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,103	08/02/2001	James M. Cisar	TELNP120USA	6778

7590

09/16/2002

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EXAMINER

LOUIS JACQUES, JACQUES H

ART UNIT

PAPER NUMBER

3661

DATE MAILED: 09/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/921,103

Applicant(s)

CISAR, JAMES M.

Examiner

Jacques H. Louis-Jacques

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-14 is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Reissue Applications*

1. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
2. Claims 23-46 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The claims fail to recite "the wheel portion being selectably rotatable about the axis to facilitate a user selecting at least one function from the plurality of functions displayed on the display, the wheel portion being transaxially moveable and wherein transaxial movement of the wheel portion initiates selection of the at least one function."

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-10, 15-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Angle et al [6,366,771].

Angle et al discloses a wireless communication network having voice and data communication capability. According to Angle et al, there is provided a portable (hand held mobile) device (item 90, figures 6 and 7; item 100, figure 18) having a housing (275 figures 6 and 7; 602, figure 18), a bar code reader (284, figure 8; 616, figures 18 and 19) and a thumb wheel (items 300, 310, figures 6 and 7; 608, figures 18 and 19) adapted to facilitate user interaction with the portable device and being rotatable about an axis, herein at least a portion of the thumb wheel extending from the housing. See also columns 7, 16-17.

The thumb wheel, according to Angle et al, being transaxially moveable to effect selection of a function performable by the device (column 7, lines 51-62).

The device or housing of Angle et al can be held by one while the thumb wheel is transaxially moved to effect selection of a function using the same one hand. See column 7.

The device, according to Angle et al further comprises a processor (325, figure 8; 609, figure 19) and a memory (330, figure 8; 611, figure 19). The processor, according to Angle et al, is user programmable and mounted within the housing. See figure 8 and column 8. The processor is adapted to execute functions selected via depressing the thumb wheel in a transaxial direction. See column 7.

Angle et al further discloses a device (figures 8 and 19) for indicating movement of the wheel portion.

According to Angle et al, as set forth in column 7, the thumb wheel (310) is rotatable continuously in either a clockwise or counterclockwise direction which functions to scroll a cursor up or down on the display screen respectively among a plurality of functions.

The device further comprises a display (280, figures 6, 7 and 8; 603, figures 18 and 19) for displaying information scanned by the bar code reader (284, 616), and the thumb wheel being employable to facilitate a user to scroll through the displayed information. The thumb wheel being employed to select a subset of the displayed information (figures 12 and 14). See columns 10-11.

The device is user programmable so as to tailor the device to be able to execute desired functions, wherein the thumb wheel being employable to scroll through the desired functions via rotation of the thumb wheel. See columns 7-8.

The hand held device, according to Angle et al, further includes a control circuit (controller 340, figure 8; decoder 613, figure 19) operatively coupled to the thumb wheel (300,

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608) and a processor (325, 609), wherein the control circuit provides at least one signal to the processor in response to movement of the thumb wheel (figures 8 and 19). See also column 8.

According to Angle et al, the thumb wheel is being employable to activate the bar code scanner (column 8, lines 35-37).

Angle et al discloses a display (280, 603) for displaying a plurality of menus, wherein the menus presenting a plurality of functions and sub-functions, and the thumb wheel being employable to navigate through the respective means (figures 12 and 14). See column 20

According to Angle et al, there is provided a transceiver 315, figure 8; 621, figure 19) to communicate to a remote computer a subset of collected data selected via the thumb wheel (figures 8 and 19). See column 11.

Angle et al discloses a plurality of executable functions comprising at least an inventory function (tracking the location and quantity of goods). See columns 1, 5.

Angle et al discloses a portable data collection network (column 2) and a wireless network for inventory control having a network backbone (columns 2, 5).

In regard to claim 40, Angle et al discloses an ID of the user and display information related to the user. However, Angle et al does disclose that the bar code reader being employable in scanning a patient's ID tag. The use of a patient is a field of use, therefore is not given patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making,

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the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Allowable Subject Matter***

5. Claims 11-14 are allowed.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4,887,968	Wickstead et al	Dec. 1989
5,539,193	Gibbs et al	Jul. 1996
5,539,194	Miller et al	Jul. 1996
5,887,269	Brunts et al	Mar. 1999
6,046,684	Hamersley et al	Apr. 2000

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H. Louis-Jacques whose telephone number is (703) 305-9757. The examiner can normally be reached on M-Th, 7:30 AM - 4:00 PM (Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A. Cuchlinski can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1111.

Jacques H. Louis-Jacques  
Primary Examiner  
Art Unit 3661

/jlj  
August 28, 2002

*Jacques H. Louis-Jacques*  
JACQUES H. LOUIS-JACQUES  
PRIMARY EXAMINER

*Gerald Goldberg*  
**APPROVED**  
**GERALD GOLDBERG**  
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